

REMARKS

Claims 1 through 22 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 9, 10, 12 through 15, 17 and 20 contain allowable subject matter. Accordingly, the only issues pivot about the patentability of claims 1 through 8, 11, 16, 18, 19, 21 and 22.

Claims 1, 16, 18, 21 and 22 have been amended to address formalistic issues. In addition, claim 1 has been amended to recite the distance between the emission layer and the substrate, adequate descriptive support for which should be apparent throughout the originally filed disclosure as, for example, page 53 of the written description, lines 8 through 23. In addition, claims 9, 12, 14, 17 and 20 have been placed in independent form. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 16, 18, 21 and 22 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner identified language in claims 1, 16, and in claims 18, 21 and 22, asserted to render the claimed inventions indefinite. This rejection is traversed.

While Applicants do not agree with the Examiner's conclusion of indefiniteness, claims 1, 16, 18, 21 and 22 have been amended to address the issues raised by the Examiner, to expedite prosecution and to overcome the stated bases for the imposed rejection. Applicants submit that one having ordinary skill in the art would have no difficulty understanding that the scope of the claimed inventions, particularly when reasonably interpreted in light of and consistent with the

written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claims 1, 16, 18, 21 and 22 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

Claims 1 through 4, 6, 8, 11, 16 and 19 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Hata in view of Motoki et al.

In the statement of the rejection the Examiner referred to various portions of Hata, presumably intending Fig. 1 as well, and asserted that Hata discloses a nitride-based semiconductor laser device corresponding to that claimed, including a light guide layer (second n-type layer that functions as an optical wave guide layer) formed between the active layer and the p-type cladding layer (according to paragraph 17). The Examiner asserted that Motoki et al. provides motivation to incorporate oxygen as a dopant in the substrate of Hata's device. This rejection is traversed.

There is a significant difference between the claimed device and the device disclosed by each of the applied references that undermines the obviousness conclusion under 35 U.S.C. § 103. Specifically, the nitride-based semiconductor laser device defined in independent claim 1 recites that the distance between the emission layer including the active layer and the substrate is within the range of about 0.5 μm to about 4 μm . No such structure is disclosed or suggested by the applied prior art.

Indeed, advertent to paragraphs [0097] and [0167] of Hata, an undoped GaN layer 3 has a thickness of approximately 0.5 μm , and n-type contact layer 4 composed of n-GaN having a

thickness of approximately 4 μm , an n-type crack-preventing layer 5 composed of n-GaInN having a thickness of approximately 0.1 μm , an n-type cladding layer 6 composed of n-AlGaIn having a thickness of approximately 0.5 μm , and an n-type cladding layer 7 composed of n-GaN having a thickness of approximately 50 nm are formed between a light emitting layer 8 and the substrate. Therefore, in Hata's device, a distance between the emission layer (light emitting layer 8) and the substrate is about 5.1 μm , which is without the scope of the present invention. The secondary reference to Motoki et al. does not cure this deficiency, because Motoki et al. make no mention of the distance between the emission layer and the substrate.

Based upon the foregoing it should be apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 1 through 4, 6, 8, 11, 16 and 19 under 35 U.S.C. § 103 for obviousness predicated upon Hata in view of Motoki et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 5 and 7 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Hata in view of Motoki et al. and Goetz et al.

This rejection is traversed. Specifically, claims 5 and 7 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Hata in view of Motoki et al. The tertiary reference to Goetz et al. does not cure the previously argued deficiencies in the attempted combination of Hata and Motoki et al.

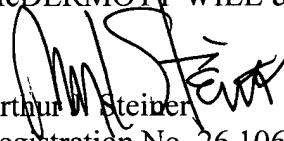
Applicants, therefore, submit that the imposed rejection of claims 5 and 7 under 35 U.S.C. § 103 for obviousness predicated upon Hata in view of Motoki et al. and Goetz et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's indication that claims 9, 10, 12 through 15, 17, 18 and 19 through 22 contain allowable subject matter. As previously noted, claims 9, 12, 14, 17 and 20 have been placed in independent form. Based upon the arguments submitted *supra*, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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